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access to the priority function, by providing a reference to the priority function...” Accordingly, it is submitted that the rejection of claim 3, and its associated dependent claims 4-7 has been overcome and should be withdrawn. Applicants have made a similar amendment to claim 10, and thus submit that the rejection with regard to claims 10-13 should also be withdrawn.

With regard to claims 18-21, Applicants submit that the language that is already present in claim 18 distinctly recites the metes and bounds of the claim, and thus requires no further amendment. Claim 18 recites “...The program product of claim 17, wherein the first protocol is programmed to provide the second protocol with access to the priority function by providing the second protocol with a pointer to the priority function...” Applicants submit that such language is clear, correct, precise and unambiguous, both when read alone and particularly when read in conjunction with lines 16-25, page 7 of Applicants’ specification. Accordingly, for the reason that this language is already clear and concise, Applicant’s respectfully request that the rejection is improper and should be withdrawn.

Claims 5, 6, 7, 12, 13, 19, 20 and 21 were also rejected under 35 U.S.C. §112, second paragraph, as not distinctly claiming the invention, because it is not understood what is meant by “forwarding the message by the second protocol to the first protocol...”

Applicants note that claims 5, 12 and 19 have been cancelled, but that their limitations have been moved to their respective independent claims, and thus applicants will still address this issue. Applicants’ submit that the above language is clear, concise and precise on its face. It is unclear to Applicant what is confusing to the Examiner, as all terms are used in their usual course. Upon further review of the office action, it would appear that the Examiner is interpreting the language of the claim using terminology from the prior art reference Baruch, and perhaps this is what is confusing to the Examiner. For example, the Examiner states, at page 5

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that (with regard to Forwarding...) "(The meaning of this is unclear. The examiner interprets this to mean that the priority associated with the first protocol is incorporated as a priority value in the second protocol.)" In fact, this is not at all what the language states, it merely states that the 'message' (as recited in the preamble) is forwarded from the second protocol to the first protocol. Applicants will address the differences with Baruch below. Accordingly, it is submitted that the rejection is improper and should be withdrawn.

Rejections under 35 U.S.C. §103

Claims 1-3, 5-10, 12-17 and 19-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baruch (U.S. Patent No: 6,487,206B1).

Baruch, U.S. 6,487,206:

Baruch describes a method of adjusting an ATM switch local service policy based on a non-ATM protocol service parameter, the method including the steps of inspecting the payload of an ATM PDU received at a switch along with at least one VCC to identify a non-ATM PDU protocol identifier included in the payload, inspecting the payload to identify a non-ATM PDU service identifier associated with the non-ATM PDU protocol identifier, and selectively adjusting a local service policy attribute within the switch for the at least one VCC based on the non-ATM PDU service identifier in accordance with an adjustment value previously associated with the non-ATM PDU protocol identifier and the non-ATM PDU service identifier. (Baruch, Abstract). Baruch's invention provides a mechanism for non-ATM PDU's (such as Ethernet frames and Internet Protocol (IP) packets that have been reformatted into ATM PDUs by the ATM adaption layer (AAL) to be transmitted between non-ATM networks via an ATM network. (Baruch, col. 1, lines 20-24). In particular, Baruch describes, at column 4, lines 54-56 "... Once the non-ATM

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protocol type and the protocol service identifier are known for the frame, the table 50 is then consulted for the corresponding CLP override and DLP values. These values are then used instead of the corresponding attribute fields from table 48 in Fig. 2..."

The Examiner has not provided a Prima-Facie case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

Applicants are confused. From a procedural standpoint, the Examiner has not provided the Applicant with an obviousness rejection. For example, the Examiner has failed to suggest any modification that should be made, and thus to present any motivation for making that modification. Applicant's can only guess that that the Examiner is actually putting forth a novelty argument. Given the unclear aspect of this rejection, Applicants respectfully request that it be withdrawn, and certainly request that the Examiner refrain from issuing a final office action in response to Applicants response, as the burden should not be on the Applicant to guess whether the Examiner views the claims to be anticipated or obvious.

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Applicants further note that there are several places in the rejection where the examiner simply makes statements that "It would be obvious ...", (page 5 line 1, page 7 lines 1-5) but fails to state the significance of the obviousness, and in particular, if the Examiner is pointing out that the cited elements are different than those that are claimed, why one would be motivated to make the substitution. The Examiner further goes on to state, at page 9, last paragraph to page 10, first paragraph that "It would be obvious ... to create a program that would performs the algorithms .. in both hardware and software; therefore it would be within the skill in the art to install this program on a computer readable medium..." Such a statement is unfounded in law. The MPEP specifically states, at section 2143 "...A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000)..."

Accordingly, for at least the reason that the Examiner has failed to provide any motivation for making a change that is deemed 'obvious', the Examiner has failed to satisfy the criteria for setting forth a *prima facie* case of obviousness. As such, the rejections under 35 U.S.C. §103 are improper and must be withdrawn.

Combination neither describes nor suggests the claimed invention

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Whether or not the Examiner deems that Baruch anticipates the claims or makes them obvious, Applicants assert that Baruch neither describes nor suggests the limitations of the claimed invention as amended.

For example, claim 1 now recites "...associating with the first protocol a priority function for assigning a priority level to the message ... invoking the priority function by the second protocol in order to determine the priority level for the message; and forwarding the message *along with an indication of the priority level for the message...*" No such structure is described or suggested by Baruch.

Rather, in contrast to 'invoking the priority function' as recited in claim 1, Baruch access a table. (Col. 4, line 55). ..Values from the table are used to override Cell Loss Priority (CLP) and Delay Priority (DLP) values for a given QoS that may not be attainable by the new protocol. No mention is made in Baruch of 'forwarding the indication of the priority level for the message' between the two protocols, because Baruch is doing something different from the claimed invention, i.e., Baruch is changing the QoS parameters for non-ATM PDU messages, as opposed to 'invoking a priority function' to determine 'a priority of a message', and 'forwarding' the message with an indication of the 'priority', as recited in the claims.

The Examiner states, at page 4, line 3 of the office action:

"... Forwarding the message by the second protocol to the first protocol (The meaning of this is unclear. The examiner interprets this to mean that the priority associated with the first protocol is incorporated as a priority value in the second protocol...)"

Such an interpretation is over-reaching, and appear to be an effort to read limitations of Baruch into the claimed invention. As clearly mentioned in the specification of the invention, at page 6, lines 17-22 "... If the protocol indicator indicates that the protocol message is a low

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priority message ... then the logic forwards the protocol message to the upper layer protocol as a low priority message, in step 516, for example, by placing the protocol message on a low priority message queue..."

Accordingly, for at least the above reason, claim 1 is patentably distinct over Baruch, and the rejection should be withdrawn. Dependent claims 2-4 and 7 serve to further narrow claim 1 and are therefore patentable with claim 1.

Independent claims 8, 15 and 22 include limitations similar to claim 1 and are allowable for much the same reasons recited above. For example, claim 8 recites "... A device comprising a priority function for assigning a priority level to a message associated with a first protocol, and a second protocol operably coupled to invoke the priority function in order to determine the priority level for the message, *wherein the second protocol is operably coupled to forward the message to the first protocol along with an indication of the priority level for the message...*"

Claim 15 recites "... A program product comprising a computer readable medium having embodied therein a computer program for providing priority forwarding of messages, the computer program comprising ... a priority function for assigning a priority level to a message associated with a first protocol; and a second protocol programmed to invoke the priority function in order to determine the priority level for the message, *wherein the second protocol is programmed to forward the message to the first protocol along with an indication of the priority level for the message...*" Claim 22 recites "... A method for forwarding a message through a layered protocol stack, the method comprising ... receiving the message by a first protocol of the layered protocol stack, invoking by said first protocol a priority function associated with a second protocol of the layered protocol stack in order to determine a priority level for the message; and

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*forwarding the message by the first protocol to the second protocol according to the priority level for the message..."*

Claims 4, 11 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baruch in view of Wills (U.S. Patent 6,002, 692).

Wills describes a switch architecture for interfacing a high speed communications broadband communication network to a communications fabric having a bandwidth that is a fraction of the high speed broadband network, and the fabric having different packet formats (Wills, Abstract).

The Examiner states, at page 12 of the Office Action "... Baruch does not particularly call for: providing the second protocol with a pointer to the priority function... Wills teaches: providing the second protocol with a pointer to the priority function ... It would be obvious to add the pointer of Wills to the method and system of Baruch in order to build an ATM system with queues..."

The motivation provided by the Examiner is insufficient, as Baruch already has an ATM system with queues, and thus it is unclear as to why Baruch would be motivated to change from the table method to using a pointer. Accordingly, for at least this reason the rejection is improper and should be withdrawn. In addition, the Wills reference, in combination with Baruch, neither describes nor suggests the limitations of the claimed invention. Further, it has been shown above that the parent independent claims related to claims 4, 11 and 18 are nonobvious. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, for the

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additional reason that claims 4, 11 and 18 depend from non-obvious claims, the claims are patentably distinct over the combination of Baruch and Wills, and the rejection should be withdrawn.

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mary Steubing, Applicants' Attorney at 978-264-6664 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

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Date

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